



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

**AMENDMENT UNDER 37 CFR 1.116  
EXPEDITED PROCEDURE –  
EXAMINING GROUP 1732**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

On 1/27/05

TOWNSEND and TOWNSEND and CREW LLP

By: [Signature]

**Corres. and Mail  
BOX AF**

**PATENT**  
Attorney Docket: 012124-001120US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Mark W. McGlothlin

Application No.: 10/781,281

Filed: February 17, 2004

For: VULCANIZATION OF DIP-  
MOLDED RUBBER ARTICLES  
WITH MOLTEN MEDIA BATHS

Customer No.: 20350

Confirmation No. 2034

Examiner: Ortiz, Angela Y.

Technology Center/Art Unit: 1732

**SUBMISSION UNDER 37 CFR 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 1732**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper and the accompanying Terminal Disclaimer are submitted in response to the Office Action mailed January 18, 2005. Once again, reconsideration of the application is respectfully requested before this application is appealed to the Board of Patent Appeals and Interferences.

The invention as expressed in the claims under examination in this application and the arguments presented in Amendment No. 2, filed November 10, 2004, are fully consistent with the case law newly cited by the examiner. As noted in the remarks accompanying

Amendment No. 2, neither of the two decisions cited in the first Office Action were directed to product-by-process claims. As a result, neither decision is on point and neither is relevant to the present application. The claims in the present application do not raise any issue of “intended use” and the claims are not drawn to a “process of making” (both quotes from the examiner’s remarks).

In the present Office Action, the examiner cites a decision (In re Thorpe et al.) that does address product-by-process claims. This decision, unlike those cited in the first Office Action, is relevant law, and it supports the patentability of the present invention. To quote the Thorpe et al. decision (a section of the quote used by the examiner), product-by-process claims “enable an applicant to claim an otherwise patentable product that resists definition by other than the process by which it is made.” This is precisely what Applicant herein has done. The decision further states that the “determination of patentability is based on the product itself.” This is also true in the present invention. The fact that the product is both different from and superior to the prior art is demonstrated by the comparative test data in the specification. As explained in the remarks accompanying Amendment No. 2, Example 7 compares dip-molded articles cured by the hot air treatment of the prior art with dip-molded articles cured by a molten salt cure of the invention and shows that the molten salt cure produces a product with tensile properties that greatly exceed those of the product produced by the hot air cure. This shows that the product obtained by a molten salt cure of dip-molded latex is both different than and superior to the product obtained by a hot air cure of dip-molded latex. The improved product cannot itself be characterized other than by the process by which it is produced. Further quoting from the Thorpe et al. decision, the product is not “the same as or obvious from” the prior art product. In all respects, therefore, the Thorpe et al. decision supports the patentability of Applicant’s product-by-process claims. Applicant does not argue that the Thorpe et al. holding is incorrect, as the examiner states. Applicants in fact agree with the holding and submit that it supports the present claims.

To respond to the examiner’s final statement, appearing at the bottom of page 5 of the Office Action, the claims of the present application already state the “novel step” that produces a different and patentably distinct product. The “novel step” is the dip-molded latex

(recited in part (a) of the first claim) vulcanized in a hot liquid bath (recited in part (c)). If the structural difference in the claim could have been articulated in words, it would have been included in the claim language. The recitations requested by the examiner, i.e., that the product is better than the prior art, are not structural features but rather performance features. They are laudatory recitations that do not belong in a claim. The improvement in performance is the result of the invention, not the invention itself, which is the product that brings about the improved performance, and that product cannot be recited other than by the process by which it was obtained.

Accordingly, reconsideration is once again requested. Should any matters remain that can be resolved by a telephone conference, the examiner is encouraged to telephone the undersigned at 415-576-0200.

Respectfully submitted,



M. Henry Heines  
Reg. No. 28,219

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
MHH:mhh  
60406097 v1